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David Goodman

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EXAMINER

LEROUX, ETIENNE PIERRE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/941,072	Applicant(s) GOODMAN ET AL.	
	Examiner Etienne P. LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-24 and 27-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-24 and 27-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2008 has been entered.

Claim Status

Claims 1-4, 6-24, 27-43 are pending.

Claim Objections

Claims 25-27 are objected to because of the following informalities:

Claims 25 and 26 must be designated as cancelled.

Claim 27 depends from a cancelled claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1-4, 6-8, 10-15, 19-24, 27, 29-35 and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Haneda (US 6,243,171).

Claims 1, 20, 33, 40, 41,43:

Haneda discloses:

determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier [the identification code on the user's disk is compared with the identification code attached to the image data preserved on the lab's disk in the laboratory system, col 20, lines 25-30]

Note:

(1) storage medium is interpreted as user's disk, col 15, lines 10-20.

(2) unique volume label is interpreted as processing serial number, col 15, lines 35-40]

(3) unique label identifier is interpreted as film number, col 15, line 43 on a bar code label, col 19, lines 5-10, Fig 10]

if the storage medium has not been assigned a unique volume label and a unique label identifier, then

(i) determining a unique label identifier for the storage medium [identification code is stored on the original film, on the user's disk, Fig 10, on the lab's disk 16, Fig 10, col 4, lines 8-15, col 19, lines 50-65]

(ii) determining a unique volume label for the storage medium [processing serial number, col 15, lines 35-40],

(iii) writing the unique volume label onto the storage medium [bar code label in Fig 10, col 19, lines 5-10]

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Note:

(1) writing the unique volume label onto the storage medium is ambiguous because it is typically interpreted as entering data directly onto the storage medium as opposed to a label which is affixed to an external surface of the user's disk. However, claim 6 includes a bar code label and so that will be the interpretation.

(iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [print label, Fig 10, col 19, lines 55-60]

updating a database with an association between each file stored on the storage medium and the storage medium [abstract, original digital image data is stored on a laboratory recording medium together with an identification code identifying the roll of film, col 20, lines 35-45, col 22, lines 55-65]

determining that at least one file contained on the storage medium has been added or deleted; and updating the database to reflect each added or deleted file [Fig 15, col 21, lines 45-60, Fig 5, col 16, 25-35]

Claim 2, 21:

Haneda discloses synchronizing the database with a database on a device apart from the read/write machine [reading the bar code on the user's disk, comparing identification codes and printing photographs, col 20, lines 50-60]

Claim 3, 13, 32:

Haneda discloses the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [bar code reader 36, col 19, lines 5-15]

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Claim 4, 22, 23:

Haneda discloses wherein the device is an untethered handheld device [bar code reader 36, col 19, lines 5-15]

Claim 6:

Haneda discloses wherein the label based on the unique label identifier is a bar code label [Figs 10, 12]

Claim 7:

Haneda discloses wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine [col 15, line 39, processing serial number]

Claim 8, 27:

Haneda discloses wherein the state information is a count sequence [col 15, line 39, processing serial number]

Claim 10, 29:

Haneda discloses accepting information read from a label associated with the storage medium without reading the storage medium, converting the accepted information into a database key, requesting records from a database instance using the database key, accepting records in response to the request and rendering information about the accepted records [Fig 2, col 19, lines 7-20, col 20, lines 50-55]

Claim 11, 30:

Haneda discloses wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from a bar code scanner [Fig 2, 36].

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Claim 12, 31:

Haneda discloses wherein the information about the accepted records rendered includes file names [Fig 14, 15].

Claim 14:

Haneda discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device [Fig 2, col 23, lines 13-18, roll of film is specified by selecting its pet name]

Claim 15, 35:

Haneda discloses:

accepting at least one search parameter from a set, the set comprising: (A) file name, (B) file size, (C) file author and (D) file type [col 22, lines 5-20]

generating a query based on the search parameters [col 22, lines 5-20]

accepting one or more records returned in response to the query generated [col 22, lines 20-25]

determining at least one label corresponding to each record [col 22, lines 5-30]

determining an external storage medium corresponding to each label [col 22, lines 55-65]

Claim 16, 36

Haneda discloses accepting information read from the machine-readable labels, if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [col 23, lines 1-10]

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Claim 17, 37

Haneda discloses if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second identifier, said second identifier able to be perceived by humans [col 23, lines 1-10, null return]

Claim 19, 39:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more labels accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim 34:

Haneda discloses means for synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, paragraph 36]

Claim 42:

Haneda discloses wherein the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted such that a user or scanner can distinguish the storage medium including the label from other storage media [Fig 2]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 4,864,616 issued to Pond et al(hereafter Pond), as best examiner is able to ascertain.

Claim 9, 28:

Haneda discloses the elements of claims 1/15 as noted above but does not disclose wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [col 3, lines 35- 55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claims 18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick), as best examiner is able to ascertain.

Claim 18, 38:

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Haneda discloses the elements of the claimed invention as noted above but does not disclose wherein the first indicator is a first audible sound, and the second indicator is a second audible sound. Raistrick discloses wherein the first indicator is a first audible sound, and the second indicator is a second audible sound [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include above limitation for the purpose of providing the user with a quick response which does not require an additional eye and/or hand movement.

Response to Arguments

Applicant's arguments filed 10/16/2009 have been fully considered but they are not persuasive.

Applicant argues that Haneda does not disclose the newly added limitations to claims 1 and 15. Applicant is referred to above Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Etienne P LeRoux/
Primary Examiner, Art Unit 2161

7/10/2009